

REMARKS/ARGUMENTS

Applicants have carefully reviewed the Office Action mailed on March 25, 2008. Applicants respectfully traverse all objections, rejections, and assertions made by the Examiner. Claims 1-12 remain pending. Claims 1, 5, 7, 10, and 12 have been amended. Support for the amendments is found in the specification, claims, and drawings as originally filed. No new matter has been added.

Claim Rejection under 35 U.S.C §102

Claims 1-12 were rejected under 35 U.S.C. §102(b) as being anticipated by Winslow et al. (U.S. Patent No. 5,885,299). This rejection is respectfully traversed. Independent claim 1 recites:

1. (Currently Amended) A spinal surgical instrument comprising: an outer cannula having a proximal end, distal end and an outer lumen passing there between, the distal end of the outer cannula configured to releasably mount to a securing arrangement for a spinal implant; an inner cannula having a proximal end, a distal end and an inner lumen passing therebetween, the inner cannula being axially moveable within the outer lumen of the outer cannula and including threads on an interior surface of the inner cannula configured to threadably engage a portion of the spinal implant, a fixing member having a proximal end and a distal end, the fixing member positioned within the inner lumen and including an arrangement for advancing and retracting the fixing member within the inner lumen of the inner cannula.

Independent claims 10 and 12 also recite threads “on an interior surface of the inner cannula”. Winslow does not appear to teach such a structure. The Examiner asserts that Winslow teaches an inner cannula 118 having a thread 144 configured to threadably engage a portion of a spinal implant. Winslow actually appears to teach an inner tubular member 118 and an inner shaft 132 mounted within the inner tubular member 118, where the inner shaft 132 has threads 144 formed on a distal end of inner shaft 132. See column 4, line 40 through column 5, line 2 and FIGS. 6A, 8A, 9A, and 10A. Winslow does not appear to teach an inner cannula including threads on an interior surface of the inner cannula, as recited in independent claims 1, 10, and 12, but rather teaches threads on a shaft 132 disposed within the inner cannula 118. The threads 144 cannot be deemed to anticipate threads on an interior surface of an inner cannula.

MPEP 2131 states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants submit that each and every element as set forth in independent claims 1, 10, 12, and the claims dependent thereon is not found, expressly or inherently, in Winslow.

Independent claim 9 recites, in part:

the inner cannula includes threads on an interior surface thereof; the distal end of the fixing member includes exterior threads; and threading the exterior threads of the fixing member with the interior threads of the inner cannula provides for advancing and retracting the fixing member within the inner lumen of the inner cannula.

Winslow does not appear to teach such a structure. As discussed above, the Examiner asserts that Winslow teaches an inner cannula 118 having threads 144. The Examiner also asserts, at page 3, last 4 lines, that Winslow teaches "distal end of the fixing member (132) includes exterior threads (44); and threading the exterior threads of the fixing member with the interior threads of the inner cannula provides for advancing and retracting the fixing member (132) within the inner lumen of the inner cannula." Winslow does not actually contain a reference number 44, but does teach:

Inner shaft 132 has third implant engaging structure 142 positioned adjacent a distal end (See FIGS. 2 and 6A). In the illustrated embodiment, this structure is threads 144 formed on a distal end of inner shaft 132.

Winslow thus appears to teach threads 144 on the inner shaft 132, but does not appear to teach any threads on the interior surface of the inner cannula 118, as asserted by the Examiner. The Examiner appears to be referring to threads 144 as being both on the inner cannula and inner shaft 132. Winslow does not support such an interpretation. Winslow does not teach the claimed structure and thus cannot be deemed to anticipate independent claim 9 and the claims

dependent thereon. Reconsideration and withdrawal of the rejection are respectfully requested.

CONCLUSION

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that the claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,
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By their attorney,

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